

Commissioner of Patents
 Serial No. 10/640,550
 Response Date September 15, 2005
 Reply to Office Action dated June 14, 2005
 Page 3

REMARKS

I. Status of the Application.

Claims 1-19 of the Application were pending as of the date of the Office Action. In the Office Action, the Examiner:

- (a) Determined that the Information Disclosure Statement ("IDS") filed on October 29, 2003 allegedly failed to comply with the provisions of 37 C.F.R. §§1.97-1.98 because the IDS did not list the publication dates in the --MM-DD-YYYY-- format;
- (b) Rejected claims 1-17 under 35 U.S.C. §103(a) as allegedly being obvious over WIPO Publication No. WO 2003/00656374 A2 for Steen et al. ("Steen") in view of U.S. Application Publication No. US 2004/0240226 A1 for Gross et al. ("Gross"); and
- (c) Rejected claims 18 and 19 under 35 U.S.C. §103(a) as allegedly being obvious over Steen in view of Gross as applied to claim 11 and further in view of U.S. Publication No. US 2005/0052864 A1 to Collip et al. ("Collip").

Applicant respectfully submits that the foregoing Statement of Common Ownership and the following remarks incorporated herein overcome the Examiner's rejections of and objections to the Application.

II. The Objection To The Information Disclosure Statement Should Be Withdrawn.

Applicant respectfully submits that the IDS filed on October 29, 2003 meets all of the requirements of 37 C.F.R. §§1.97-1.98 and MPEP §609, because Applicant provides the requested dates. While form PTO/SB/08A for the IDS suggests that the dates be provided in the --MM-DD-YYYY-- format, neither 37 C.F.R. §§1.97-1.98 nor MPEP §609 requires that the

Commissioner of Patents
Serial No. 10/696,224
Response Date September 15, 2005
Reply to Office Action dated June 15, 2005
Page 4

dates be placed in this format. Rather, 37 C.F.R. §§1.97-1.98 only requires that the date be provided. The relevant portion of 37 C.F.R. §1.98 states that:

[e]ach U.S. Patent listed in an information disclosure statement must be identified by inventor, patent number, and *issue date* [e]ach U.S. patent application publication shall be identified by . . . applicant, patent application publication number, and *publication date* [e]ach foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or the patent office which issued the patent or published application, an appropriate document number, and the *publication date* listed on the patent or published patent application.

37 C.F.R. §1.98(b)(1-2 & 4). Applicant respectfully submits that nothing in either 37 C.F.R. §§1.97-1.98 specifies that the format of the requested dates must --MM-DD-YYYY-- as suggested by the Examiner.

Moreover, while the MPEP encourages applicants to use form PTO/SB/08A, Applicant respectfully submits that nothing in MPEP §609 requires that the dates be placed in a specific format. (MPEP §609, pp. 600-125 & 600-127-600-130). Accordingly, Applicant respectfully submits that IDS should be accepted and considered because the originally filed IDS contains the necessary dates in either the --M-D-YYYY--, --M-DD-YYYY--, --MM-D-YYYY--, and --MM-DD-YYYY-- format. Despite a correction being unnecessary, Applicant resubmits the IDS with all dates listed in the requested --MM-DD-YYYY-- format to further prosecution of this Application. Applicant notes that all the foreign documents that do not appear in English are summarized in an English abstract that in combination with the figures, summarizes Applicant's knowledge of the relevance of each of these non-English documents. For these reasons, Applicant respectfully submits that the objection to the IDS should be withdrawn and all the listed references should be considered.

Commissioner of Patents
Serial No. 10/696,224
Response Date September 15, 2005
Reply to Office Action dated June 15, 2005
Page 5

III. The Rejections Of Claims 1-17 Under 35 U.S.C. §103(a) As Being Obvious Over Steen In View Of Gross Should Be Withdrawn.

Applicant respectfully submits that the rejection of claims 1-17 should be withdrawn because Gross is disqualified as being prior art under 35 U.S.C. §103(c).

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section (103) where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. §103(c) (*See also*, MPEP §706.02(k)&(l)). Gross only qualifies as prior art under 35 U.S.C. §102(e) because it was published after the filing date of the Application. Moreover, in accordance with MPEP §706.02(l)(2)(II), Applicant establishes common ownership of Gross and the Application at the time the invention of the Application was made by providing the required Statement of Common Ownership on page 2 of this response. Thus, Applicant respectfully submits that Gross is disqualified as prior art under section 35 U.S.C. §103(c) and cannot be relied upon to reject claims 1-17 under 35 U.S.C. §103(a).

While Applicant respectfully disagrees that a combination of Steen and Gross taught or suggested all the limitations of claims 1-17, Applicant respectfully submits the differences of the claimed inventions and the combination of Steen and Gross do not need to be discussed because Gross is disqualified as prior art. Further, Applicant respectfully submits that Steen does not disclose, teach or suggest all of the limitations of claims 1-17. To establish a *prima facie* case of obviousness, "all of the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)). While the Examiner does not list all of the differences between the claimed inventions and Steen, the Examiner does state that

Commissioner of Patents
Serial No. 10/696,224
Response Date September 15, 2005
Reply to Office Action dated June 15, 2005
Page 6

Steen does not teach or suggest all of the limitations of claims 1-17. (Office Action, pp. 2-5). Accordingly, Applicant respectfully submits that the rejection of claims 1-17 under 35 U.S.C. §103(a) should be withdrawn because Gross is disqualified as prior art under 35 U.S.C. §103(c) and Steen does not disclose, teach or suggest all of the limitations of claims 1-17.

V. The Rejection of Claims 18-19 Under 35 U.S.C. §103(a) Should Also Be Withdrawn.

Applicant respectfully submits that the rejection of claims 18-19 under 35 U.S.C. §103(a) should also be withdrawn because the claims depend from an allowable base claim. "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing *In re Fine*, 837 F.2d 1382, 1385 (C.C.P.A. 1970)). The Examiner rejected claims 18-19 based on the application of Steen in view of Gross to claim 11 and further in view of Collip. As noted above, Gross has been disqualified as prior art under 35 U.S.C. §103(c) and Steen, by the Examiner's own admission, does not teach or suggest all of the limitations of claim 11. Accordingly, Applicant respectfully submits that the rejection of claims 18-19 under 35 U.S.C. §103(a) should be withdrawn because the claims depend from allowable base claim 11.

Commissioner of Patents
Serial No. 10/696,224
Response Date September 15, 2005
Reply to Office Action dated June 15, 2005
Page 7

CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that original claims 1-19 are allowable claims. Allowance of this Application is therefore respectfully requested. In the event Applicant has inadvertently overlooked the need for payment of any fees, Applicant conditionally petitions therefore, and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

ICE MILLER


Alexander D. Forman, 51,691

ICE MILLER

One American Square, Box 82001
Indianapolis, IN 46282-0200
Telephone: (317) 236-5826
Facsimile: (317) 592-5433

Date: September 15, 2005

ADF

Enclosures: Fax Transmittal Sheet
Corrected Information Disclosure Statement